



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,654	10/06/2000	David Allison Bennett	PSTM0015/MRK	9943

29524 7590 02/04/2005

KHORSANDI PATENT LAW GROUP, A.L.C.  
140 S. LAKE., SUITE 312  
PASADENA, CA 91101-4710

EXAMINER

WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/680,654

Applicant(s)

BENNETT ET AL.

Examiner

Jamisue A. Webb

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.--

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above claim(s) 22-25, 53-56 and 71-90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21, 26-52 and 57-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/22/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The application is in response to Amendment filed 11/03/04.

### ***Specification***

2. The use of the trademarks UPS, USPS, FedEx, Mailboxes Etc., and Airborne Express have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The applicant has made an attempt to correct some of the deficiencies regarding the use of trademarks, but has not fixed all of them, such as the ones listed above.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 32-38, 41-51, and 56-61 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. The basis of this rejection is set forth in a two-prong test of:

- a. whether the invention is within the technological arts; and

b. whether the invention produces a useful, concrete, and tangible result.

4. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e. the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use or advance the technological arts. In the present case, Claims 1-7, 13-21, 26-38, 41-51, and 56-61 only recites an abstract idea. The recited steps of merely displaying an online interactive graphic for comparison of rates and calculating rates based on delivery time and date does not apply, involve, use or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. Even though the claim recites the user accessing a computer system, these steps only constitute an idea of how to apply these rules to choose one carrier over another, they do not require the use of the computer system to do them. And even though there is an online interactive graphic, the claims never specifically state any steps of collecting any information or manipulation of any data.

5. As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is a positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, the claims state a method of using a computer system wherein the computer system comprises a computer, none of the recited steps require

Art Unit: 3629

anything in the technological arts, as explained above. The claim merely states a method of displaying information, where the computer is capable of communication over a global network. Looking at the claim as a whole, nothing in the body of the claim recites any structure of functionality to suggest that a computer performs the recited steps. Therefore the preamble is taken to merely recite a field of use.

6. Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. In the present case, the method states it uses a computer, however the computer is not used for anything merely to display information.

7. Additionally for a claimed invention to be statutory, the claimed invention must produce a useful, concrete and tangible result. In the present case, the claimed invention produces calculated rates for carriers used in selecting a specific service for shipping (i.e., useful and tangible).

8. Although the recited process produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, Claims 32-38, 41-52, and 57-62 are deemed to be directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-21, 26-52, and 57-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara (6,233,568) in view of UPS® Service Guide ([www.ups.com](http://www.ups.com)) and FedEx® Services ([www.fedex.com](http://www.fedex.com)) and Barnett et al. (6,369,840).

6. With respect to Claims 1-4, 13-19, 21, 26-28, 32-35, 44-50, 52, 57-59, and 63-67: Kara discloses an onscreen interactive display with a selection and comparison section for a plurality of carriers with a plurality of services (See Figure 8). However Kara does not specifically disclose the rates being calculated with respect to time. Both UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the time sensitive “urgency” services, as disclosed by FedEx® and UPS®, in order to ship thing and compete with a time advantage using guaranteed delivery times and to reduce costs, when delivery time is not of importance. (See Fed Ex Page 1). Kara, UPS® and FedEx® fail to disclose the use of a graph which simultaneously displays a graph of shipping fees and services, where one axis being date and one axis being time and where each cell is located at the intersection of the date and time. Barnet discloses the use of a calendar which can be sued for

Art Unit: 3629

online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to display the calculation of shipping rates, calculated by Kara, UPS® and FedEx®, in the format of a plurality of cells with date on one axis and time on another, as disclosed by Barnett, in order to provide a multi-layers system wherein different categories can be overlaid on one another providing a single integrated display that allows a user to order or purchase a system based on the calendar day and time (See Barnett, column 2).

7. With respect to Claims 5 and 36: Barnett discloses subdividing each cell with the plurality of services (See Figures 12 and 13).

8. With respect to Claims 7 and 38: Barnett discloses the display can be checked (See Figures 8 and 9 with corresponding brief descriptions), and therefore the examiner considers this to be a selection button.

9. With respect to Claims 6, 20, 37 and 51: Kara and Barnett above discloses the claimed invention, but fails to disclose the use of colorizing the display. It is old and well known in the art that colorizing a display so distinguish one service or one carrier from another. This is done in legends on a map, or a legend in a bar graph, where each bar is colorized to represent a specific group of data. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to colorize the display so that each carrier has a different color, due to the fact that this technique is old and well known in the art.

Art Unit: 3629

10. With respect to Claims 8-12, 29-31 and 39-43, 60-62, 68-70: Kara and Barnett disclose the use of the interactive display but fails to disclose when the curser is placed on the cell it displays details of the specific service (in this instance details of the carrier and service). It is old and well known in the art that when a selection or service that is available, when a cursor is placed over the selection a detailed popup window is displayed and once the service is clicked on it is started up. This is done in the Microsoft® Windows™ environment. When a cursor is placed over a file a more detailed description of the file is popped up, and once the file is slicked on, the file is opened up or the program is started. This is done in the taskbar that is located at the bottom of the monitor. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a pop up window giving details of the carrier service and then once the cell is clicked the service is selected, due to the fact that this feature is old and well known in the art to display more detailed information upon selection.

11. With respect to Claims 9, 10, 12, 31, 40, 41, 43, 62 and 70: Kara discloses once the service is selected a shipping layer with respect to the carrier is displayed (See Figure 9).

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 1-21, 26-52 and 57-70 have been considered but are moot in view of the new ground(s) of rejection. Due to the amendment to the claims, the rejection was modified and the arguments are not drawn towards the claims how they are currently amended. Applicant has made a blanket statement that Kara, whether considered alone, or in combination with any references of record, does not disclose, anticipate or suggest the subject matter of the amended claims, but does not state why there is no motivation to



Art Unit: 3629

combine the references as applied to the claims in the above rejection. The examiner considers Kara, as combined with UPS®, FedEx® and Barnett above, to contains sufficient motivation to combine, therefore the rejections stand as stated above.

13. With respect to Applicant's argument that Barnett does not disclose displaying the rates according to date/time matrix, but rather discloses a multi-layered calendaring system of events: Barnett specifically states that the calendar, where time is on one axis and date is on another is used for an event or a service. It is the examiner's position that shipping is considered a service, therefore considers the motivation to combine to be sufficient. As far as Barnett calling it a calendaring system and the present invention calling it a matrix, they are still displayed in the same format, where the time is on one axis and the date is on the other, and the service is displayed where the two intersect. Therefore, the rejections stand as stated above.

### *Conclusion*

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3629

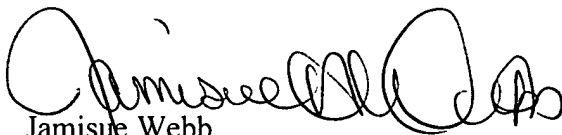
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579.

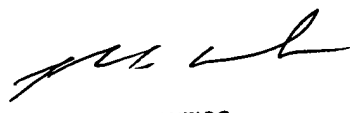
The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jamisue Webb



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 22